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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,323	09/30/2003	Jerry J. Liu	10030761-1	4662

7590 11/19/2008
AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

BAHTA, KIDEST

ART UNIT	PAPER NUMBER
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2123

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,323	Applicant(s) LIU ET AL.	
	Examiner KIDEST BAHTA	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for system and computer readable medium claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result.

Claims 1, 5 and 10 recites a system and method for receiving and transforming data from the first to the second data type. These claims subject matter lacks a practical application since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having a real world value. More specifically, the claimed subject matter is software and not tangible.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards et al. (US 2002/0156795).

Regarding claims 1, 5 and 10-11, Edwards discloses,

A system for delivering a data object to a component in a distributed network, comprising ([0002]): a first data type representation, wherein data fields in the data

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object are mapped into the first data type representation (0006]; [0022]) ; a second data type representation; and means for transforming the first data type representation into the second data type representation (Abstract, Methods and systems for enabling arbitrary components to communicate with each other. The communication system includes a first set of components associated with one or more universal interfaces that include mobile code. The one or more universal interfaces comprise a data source interface, a data sink interface, an aggregation interface, a mutable aggregation interface, a context interface, a notification interface or a user interface. Further, the universal interfaces associated with the first set of components can be provided to and implemented by a second set of components to enable the second set of components to communicate with the first set of components despite the first set and the second set of component utilizing different communication mediums or protocols).

Regarding claims 2 and 7 Edwards discloses,

The first data type representation comprises a container data type representation and the second data type representation comprises a native data type representation ([0027]-[0028]).

Regarding claims 3, 4 and 8, 9, Edwards discloses,

The native data type representation corresponds to the container data type representation and comprises an incomplete native data type representation ([0032]).

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Regarding claims 6 and 12-18, Edwards discloses,

The interface transmits the first data type representation to the component when the second data type representation is not available and transmits the second data type representation to the component when the second data type representation is available ([0042])

The transforming of the first data type representation into the second data type representation when the second data type representation is available comprises transforming the first data type representation into the second data type representation when the second data type representation is available and a component elects to receive the second data type representation ([0046]).

transmitting the first data type representation to a component when the second data type representation is not available ([0045]).

determining if the first data type representation can be transformed into an incomplete second data type representation when the second data type representation is not available ([0042]).

transforming the first data type representation into the incomplete second data type representation when the first data type representation can be transformed into the incomplete second data type representation ([0046]).

transmitting the incomplete second data type representation to a component ([0047]).

transmitting the first data type representation and the incomplete second data type representation to a component ([0047]).

Response to Arguments

3. Applicant's arguments filed 8/20/08 have been fully considered but they are not persuasive.

Regarding claims 1, 5 and 10, applicant argues that Edwards fails to disclose the limitations of claims 1, 5, 10. However, Examiner disagrees since the claims are broad, which claimed the first data and second data communicating when the data is available. Edward discloses such limitation, see ([006] and [0022]),

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed Kideest Bahta whose telephone number is 571-272-3737. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAG system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kideest Bahta/

Primary Examiner, Art Unit 2123